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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/608,539	06/30/2003	Neal Manowitz	07095.0020-01000	8271
22852 7590 05/16/2007 FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER HO, TUAN V	
			ART UNIT 2622	PAPER NUMBER
			MAIL DATE 05/16/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/608,539	MANOWITZ ET AL.	
	Examiner	Art Unit	
	Tuan V. Ho	2622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 35-108 is/are pending in the application.
- 4a) Of the above claim(s) 109-122 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 35-108 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 June 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1. Applicants' election of Group I, claims 35-108 without traverse is acknowledged. Claims 109-122 are withdrawn from further consideration on the merits as non-elected claims.
2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.
3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 35-108 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-24 of U.S. Patent No. 6,614,470. Although the conflicting claims are not identical, they are not patentably distinct from each other because:

With regard to claim 35, claim 35 is an obvious variant and encompassed by claim 1 of the Patent'470.

With regard to claims 36-42, claims 36-42 correspond to claims 2-6 of the Patent'470.

With regard to claim 43, Official Notice is taken for a disk storage medium.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the data storage device of claim 42 so as to obtain a disk storage medium because the modification of the data storage medium with a disk storage medium would allow a user to store digital images with less cost and more reliability.

With regard to claims 44-46, Official Notice is taken for a printer (in claim 44), electronic mail transmission (in claim 45) and wireless command (in claim 46).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of claim 1 so as to incorporate the printer,

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electronic email transmission or wireless command in order to provide hard copies from the digital images, transmit the images via email and control the system by wireless remote control because the incorporation of those items would allow a user to have more choices to distribute the images and thereby to provide more efficiency the system in claim 1.

Claims 47-61 recite what was previously discussed with respect to claims 35-46.

With regard to claim 62, claim 62 is an obvious variant and encompassed by claim 8 and 9 of the Patent'470. It should be noted that claimed display system I met by television receiver.

Claims 63-73 and 74-102 recite what was previously discussed with respect to claims 36-46.

With regard to claims 103 and 105, claims computer readable medium is met by a processor of claim 1 since the processor is inherently included computer programs having computer instructions.

Claims 94-102 recites what was previously discussed with respect to claim 36-46.

With regard to claims (103, 104) and (105, 106), claims (103 and 104) and (105 and 106) are an obvious variant and encompassed by claims 18.

With regard to claims 107 and 108, Official Notice is taken for claimed "printing device" in claim 107 and storage device in claim 108.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the apparatus of claims 17 and 18 so as to incorporate a printing device or storage device in order to obtain the claimed apparatus including a printing device and storage device because the modification of the apparatus of claim 17 and 18 would allow a user to provide hard copies and store digital images in a hard drive and there by to provide a user with more selections of image distributions.

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 105 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter as follows. Claim 105 defines a computer program embodying functional descriptive material. However, the claim does not define a computer readable medium or memory and is thus non-statutory for that reason. That is, the scope of the presently claimed computer program product can range from paper on which

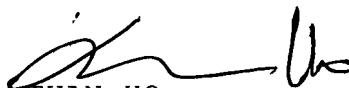
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the program is written, to a program simply contemplated and memorized by a person.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to TUAN HO whose telephone number is (571) 272-7365. The examiner can normally be reached on Mon-Fri from 7AM to 4PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's acting supervisor, David Ometz can be reached on (571) 272-7593. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Customer Service whose telephone number is (571) 272-2600.



TUAN HO

Primary Examiner

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